

## **REMARKS**

In the Office Action, Claims 1-3, 5-8, 11-14, 31-35, and 41 were examined and stand rejected. In response, Claims 1 and 11 are amended, no claims are cancelled, and no claims are added. Applicants respectfully request reconsideration of pending Claims 1-3, 5-8, 11-14, 31-35, and 41 in view of at least the following remarks and amendments.

### **I. Double Patenting**

Claims 1-3, 5-8, 11-14, and 31-35 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-29 over co-pending U.S. Patent Application Publication No. 2007/0223704. Applicants hold in abeyance this rejection until such time as the claims on which the rejection is premised are granted.

### **II. Claim Rejections Under 35 U.S.C. §103**

Claims 1, 11, and 31 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,278,837 to Best (“Best,” previously cited) and U.S. Patent 7,181,620 to Hur (“Hur”).

Claim 1 recites:

1. A method comprising:  
programming a chip secret key into a manufactured chip;  
sending the manufactured chip to a system original equipment manufacturer (OEM); and  
generating at least one private key for the manufactured chip in response to a received key update request if the received key update request is authenticated. (Emphasis added.)

While Applicant’s argument here is directed to the cited combination of references, it is necessary to first consider their individual teachings, in order to ascertain what combination (if any) could be made from them.

Best is generally directed to a crypto-microprocessor chip that executes an enciphered program by piecemeal deciphering of enciphered instructions as needed. By deciphering small portions of the program only when they are needed, Best avoids any need for storing the program in deciphered form. (See col. 4, lines 41-46.) In contrast with Claim 1, Best does not disclose or

suggest generating at least one private key for a manufactured chip in response to a received key update request if the received key update request is authenticated. Best discloses that the enciphering process of unit 184 is performed under the control of a secret cipher key, that is loaded into CMP 16 via line 163 by unit 184. (See col. 4, lines 60-65.) However, loading of the key into CMP, for storage into register 5 and the removal of such lines prior to distribution of CMP to users, does not disclose or suggest the generation of at least one private key for a manufactured chip in response to a received key update request, much less if the received key update request is authenticated, as in Claim 1.

According to the Examiner, this feature of Claim 1, prior to amendment, is disclosed by Best at col. 14, lines 15-67. However, the passage referred to by the Examiner describes operation of unit 184 for storing the key into CMP 116. In contrast with Claim 1, the passage referred to by the Examiner is directed to the explicit requirement that the storing of the key into the CMP is done at a different time and by a different operator than the storing of the enciphered program into memory 12. (See col. 14, lines 15-20.) Hence, neither this passage, nor any other portion of Best, either discloses or suggests generation of a private key in response to a received key update request, much less that private key generation is conditioned on authentication of the received key update request, as in Claim 1.

As correctly recognized by the Examiner, Best does not teach or suggest authentication of the received key update request, as in Claim 1. As a result, the Examiner cites Hur. We respectfully disagree with the Examiner's assertions and characterizations regarding Hur.

Hur generally relates to a cryptographic key distribution for network devices with minimal preconfiguration. As described by Hur, a first device, seeking secure communications with a second device, registers with a registration service to obtain a long-lived symmetric key. This key is used for registration with a key management service to receive a short-lived symmetric key. Hur teaches that the symmetric key is used to establish a session key for secure communication with the second device (see Abstract). According to the Examiner, authentication of the key request as in Claim 1 is disclosed by the Abstract, col. 6, lines 18-40, and col. 10, lines 33-38 of Hur. However, the passages referred to by the Examiner merely describe the use of a key management service to retrieve a short-lived symmetric key that is used to establish a session key for secure communication with a second device. We submit that the

Examiner's citing of Hur fails to rectify the deficiency of Best in teaching or suggesting the combination of programming a chip secret key into a manufactured chip and generating at least one private key for the manufactured chip in response to a **received key update request** if the key update **request is authenticated**, as in Claim 1.

Furthermore, while Claim 1 is directed to programming a chip secret key into a manufactured chip and generating a private key for the manufactured chip in response to an authenticated key update request, Hur relates to devices with minimal preconfiguration, and not the manufactured chips, as in Claim 1. Moreover, neither Best nor Hur describes a combination of programming a chip secret key into a manufactured chip and generating at least one private key for the manufactured chip in response to an authenticated received key update request, as in Claim 1. The Examiner's reliance on Best to disclose a combination of programming a chip secret key into a manufactured chip and generating at least one private key for the manufactured chip in response to a received key update request is improper. Best does not provide both programming of a chip secret key into a manufactured chip, and generating at least one private key for the manufactured chip in response to a received key update request, since the portions of Best referred to by the Examiner are limited to the storage of a key into CMP 116, by generating a random number for use as a key. Hence, no combination of Best in view of Hur can teach or suggest the combination of programming a chip secret key into a manufactured chip and generating at least one private key for the manufactured chip in response to a key update request, if the received key update request is authenticated, as in Claim 1.

Therefore, the Examiner has failed to identify, and Applicants are unable to discern any portion of Best and Hur or the references of record, that discloses, teaches, or suggests the combination of programming a chip secret key into a manufactured chip and generating at least one private key for the manufactured chip in response to a received key update request if the received key update request is authenticated, as in Claim 1.

For each of the above reasons, Claim 1 and all claims which depend from Claim 1 are patentable over Best and Hur, as well as the references of record. Therefore, please reconsider and withdraw the §103(a) rejection of Claim 1.

Each of the Applicant's other independent claims, and each claim which depend from those claims are patentable over the cited art for similar reasons. Therefore, please reconsider and withdraw the §103(a) rejection of Claims 11 and 31.

**IV. Allowable Subject Matter**

Claims 2, 3, 5-8, 12-14, and 32-35 were objected to in a previous Action as being dependent upon a rejected base claim, but indicated as allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding Claims 2, 3, 5-8, 12-14, and 32-35, Claims 2, 3, 5-8, 12-14, and 32-35, based on their dependency from Claims 1, 11 and 35, respectively, are also patentable over Best and Hur, as well as the references of record. Therefore, Applicants respectfully request that the Examiner allow Claims 2, 3, 5-8, 12-14, and 32-35.

### Conclusion

In view of the foregoing, it is believed that all claims now pending (1) are in proper form, (2) are neither obvious nor anticipated by the relied upon art of record, and (3) are in condition for allowance. A Notice of Allowance is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated: September 8, 2008

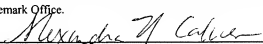
By: 

Joseph Lutz, Reg. No. 43,765

1279 Oakmead Parkway  
Sunnyvale, California 94085-4040  
Telephone (310) 207-3800  
Facsimile (408) 720-8383

#### CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.

  
Alexandra Y. Caluen

September 8, 2008